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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,324	02/07/2002	Mutsumi Harada	X2007.0002/P002	4579

7590 10/19/2004

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EXAMINER

DUONG, THANH P

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/067,324	Applicant(s) HARADA ET AL.	
	Examiner Tom P Duong	Art Unit 1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 13-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 13-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

1. Claims 1-7 and 13-18 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kobayashi (6,558,273). Regarding claims 1-2 and 13-18, Kobayashi discloses a metal golf club head (Fig. 2), comprising: a ball hitting face (16) made of a metal (Col. 4, lines 20-21), which includes a central portion (as shown on Fig. 2) and a peripheral portion surrounding at least a part of said central portion (as shown on Fig. 2). With respect to the hardness of the metal at said peripheral portion is lower than the hardness of the metal at said central portion, Kobayashi discloses the face member is subject to direct aging treatment to improve surface hardness (Col. 6, lines 11-14) and further discloses the outer periphery of the face member is welded to the body member 17 after heat treatment. Note, it is known in the golf club art that the surface hardness is reduced in the affected welding zone area (See USPN 6,280,349 and USPN 5,275,409). In light of applicants' specification (page 8, lines 5-15), it is inherent and/or obvious in view of Kobayashi to one having ordinary skill in the art that the face member of Kobayashi has a higher

surface hardness in the central portion than its periphery portion being the fact that the periphery portion are subjected to the affected welding area, which has a lower surface hardness than the central portion (unwelded surface area). Regarding claims 3 and 4, Kobayashi does not disclose the method of determining the hardness difference between the central portion and its periphery portion; however, it is inherent and/or obvious in view of Kobayashi to one having ordinary skill in the art that the face member of Kobayashi has a hardness difference between the central portion and its periphery portion as described above. With respect to claims 5-7, Kobayashi does not disclose the difference in the hardness between said central portion and periphery portion is equal to or greater than 50 in terms of the Vickers hardness. However, Kobayashi discloses the face material with heat treatment and welding technique of the claimed invention; thus, it is inherent and/or obvious in view of Kobayashi to one having ordinary skill in the art that the face member of Kobayashi exhibits the hardness characteristics of the claimed invention. Note, when the claimed and prior art products are identical or substantially identical in structure or composition, or produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 255, 195 USPQ 430, 433 (CCPA 1977). See MPEP 2112.01.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 6,280,349 and USPN 5,275,409 disclose the hardness of the material is reduced in the affected welding zone.

Response to Arguments

Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom P Duong whose telephone number is (571) 272-2794. The examiner can normally be reached on 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tom Duong
October 5, 2004

TD


Glenn Caldarola
Supervisory Patent Examiner
Technology Center 1700